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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/205,119	12/03/1998	CHARLES A. ELDERING	8887-3004	8185

27832 7590 07/31/2003

EXPANSE NETWORKS, INC.
6206 KELLERS CHURCH ROAD
PIPERSVILLE, PA 18947

EXAMINER

LONSBERRY, HUNTER B

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 07/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Interview Summary	Application No.		Applicant(s)	
	09/205,119		ELDERING ET AL.	
	Examiner		Art Unit	
	Andrew Faile		2611	

All participants (applicant, applicant's representative, PTO personnel):

(1) Andrew Faile (3) _____

(2) Doug Ryder (4) _____

Date of Interview: 26 March 2003.

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.
If Yes, brief description: _____

Claim(s) discussed: 42 and 56.

Identification of prior art discussed: None.


Agreement with respect to the claims f) ☒ was reached. g) ☐ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Applicant was informed that the Final Rejection mailed 11/5/02 is hereby vacated. The after Final Amendment received on 12/5/02 will be entered in the application and an Office Action on the merits will be forthcoming.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

i) ☒ It is not necessary for applicant to provide a separate record of the substance of the interview (if box is checked).

Unless the paragraph above has been checked, THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.


ANDREW FAILE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Examiner's signature, if required

Office Action Summary	Application No.	Applicant(s)	
	09/205,119	ELDERING ET AL.	
	Examiner Hunter B. Lonsberry	Art Unit 2611	

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —
 Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 42-46 and 48-73 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 42-46 and 48-73 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 December 1998 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

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DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 46 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,457,010.

Application claim 46 corresponds to claim 1 of Patent 6,457,010 given that the claims are drawn to the same invention, differing only in scope (claim 46 is a broader recitation of the invention than patent claim 1).

Allowance of claim 46 would result in an unjustified timewise-extension of the monopoly previously granted for the invention defined by patent claim 1, therefore, obvious type double patenting is appropriate.

Claim 52 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,457,010.

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Application claim 52 corresponds to claim 1 of Patent 6,457,010 given that the claims are drawn to the same invention, differing only in scope (claim 46 is a broader recitation of the invention than patent claim 1).

Allowance of claim 52 would result in an unjustified timewise-extension of the monopoly previously granted for the invention defined by patent claim 1, therefore, obvious type double patenting is appropriate.

Claim 60 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,457,010.

Application claim 60 corresponds to claim 1 of Patent 6,457,010 given that the claims are drawn to the same invention, differing only in scope (claim 46 is a broader recitation of the invention than patent claim 1).

Allowance of claim 60 would result in an unjustified timewise-extension of the monopoly previously granted for the invention defined by patent claim 1, therefore, obvious type double patenting is appropriate.

Claim 60 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 78 of copending Application No. 09/204,888. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are drawn to the same invention, differing only in scope ("monitoring subscriber interaction to advertisements presented" of the current applicant corresponds to "monitoring subscriber viewing

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interactions" of claim 78, "processing subscriber interactions in order to define traits associated with the subscriber interactions" of claim 60 corresponds to "processing the subscriber television viewing interactions and content characteristics to generate subscriber television viewing habits" of claim 78, "wherein the heuristic rules associate the traits to characteristics about the subscriber that are not directly related to the interactions" of claim 60 to "wherein the heuristics rules associate the subscriber television viewing habits with non television viewing characteristics about the subscriber" of claim 78) :

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 42, 46 and 60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The scope of the claim language "not directly related to the subscriber interactions" is not well understood as one cannot ascertain the relationship between the subscriber traits and interactions as it is not well understood what constitutes a direct or indirect relationship between the two.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 42-46, and 48-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,796,952 to Davis in view of U.S. Patent 6,236,978 to Tuzhilin and U.S. Patent 6,177,931 to Alexander.

Regarding claims 42-46, 48, 49, 52, 60-61, 66 and 71-74, Davis discloses a user monitoring system which monitors a users interactions with a web page and advertising as well as a user's inactivity on the webpage via timer to account for a user reading the webpage, this information is stored in a database and builds a profile based upon subscriber interactions (column 8, lines 30-column 9, line 45, column 11, lines 13-33, column 12, line 51- column 13, line 18, lines 47-63). Davis does not disclose identifying traits about a user not directly related to subscriber interactions, and the use of heuristic rules to associate subscriber interactions and non-interactions to the subscriber's characteristics. Tuzhilin discloses a system which utilizes a number heuristic rules to create a dynamic consumer profile, which tracks user interactions and traits; the system then estimates a users future needs as well as which products a user is most likely to purchase, the rules are retrieved and generated in order to determine the dynamic profile, for example Tuzhilin utilizes a rule which is applied to a group of men, (IF Sex="Male" and Shopping_time="evening" and Day_of_week="weekday" and Purchase="Diapers" THEN Purchase="beer".), this rule is not specific to any one

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individual, but instead is applied to a group of users or may be applied to a customer record based upon a number of data point, in this particular example, the data points, male, shopping time and first purchase are inserted into the heuristic rule, and the trait identified is that the user would also buy beer, the purchase of the beer is unrelated to the purchase of the diapers as the beer purchase is not a data point retrieved from a user's buying history (Figures 4 and 6, column 3, line 58-column 4, line 29, column 5, line 47-column 6, line 44, column 8, line 20-47, column 11, lines 42-66). Alexander discloses a viewer profiling system which monitors a users viewing habits and internet browsing, and is able to determine a users martial status, number of children and age (column 28, line 13-67, column 30, line 1-44), Therefore it would have been obvious to one skilled in the art at the time of invention to modify Davis to utilize the rules and recommendation system of Tuzhilin and viewing habits of and profiling features of Alexander in order to utilize the non interaction data of Davis to determine which advertisements or webpage a user has seen and read in order to more accurately create a user profile which is tailored to a user's interests.

Regarding claims 50 and 51, Tuzhilin discloses that the rules are and profiles are probabilistic (column 4, line 30-column 5, line 45).

Regarding claims 53 and 55, Tuzhilin discloses that the profile identifies demographic and product interest characteristics of a subscriber such as age or past purchasing history (column 3, lines 31-50).

Regarding claim 54, Tuzhilin discloses that the rules predict product interest characteristics about the subscriber (column 13, lines 38-column 14, line 14).

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Regarding claims 56-59 and 69-70, Alexander discloses that the user's EPG will monitor channel changes, and the programming displayed on the channel changed too, identification of advertisements on screen and column changes and the time of the channel change (column 28, lines 13-59).

Regarding claim 62, Tuzhilin discloses that subscriber's interactions are aggregated via their purchase history (column 13, line 38-column 14, line 14).

Regarding claims 63 and 64, Davis discloses aggregating subscriber interactions for single and multiple sessions to determine user interests (column 11, lines 13-33, column 12, lines 51-column 13, line 17).

Regarding claims 67 and 68, Davis discloses that the click through rate for advertising is monitored; this data is used to determine a subscribers interests (column 13, line 47-column 14, line 65).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 6,460,036-B1 to Herz, System and Method for Providing Customized Electronic Newspapers and Target Advertisements.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hunter B. Lonsberry whose telephone number is 703-305-3234. The examiner can normally be reached on Monday-Friday during normal business hours.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 703-305-4380. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-5359 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

HBL
July 25, 2003


ANDREW FAILE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600